



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,955	09/25/2003	Daniel T. Colbert	11321-P011CD2D1	7093

7590 09/11/2006

Ross Spencer Garsson
Winstead Sechrest & Minick P.C.
1201 Main Street
P.O. Box 50784
Dallas, TX 75250-0784

EXAMINER

FIORITO, JAMES

ART UNIT	PAPER NUMBER
----------	--------------

1754

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,955

Applicant(s)

COLBERT ET AL.

Examiner

James A. Fiorito

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84,85,91,92,94 and 95 is/are pending in the application.
- 4a) Of the above claim(s) ~~84,85,91,92,94 and 95~~ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84,85,91,92,94 and 95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Applicant refers to serial number 08/687665 on page 34 of the specification, which is now patent number 6183714.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 94 and 95 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification teaches that the ends of the single-wall carbon nanotubes are open, or closed. However, a combination of open and closed nanotubes is not taught in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 84-85, 91-92, and 94-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiura (US 5698175) in view of Iijima (Nature, Vol 363, June 1993).

Hiura discloses a method for producing end-derivatized carbon nanotubes comprising the steps of: a) providing a plurality of carbon nanotubes with at least about 100 carbon atoms; and b) reacting the carbon nanotubes with a compound that provides at least one substituent on at least one of the ends of at least a portion of the carbon nanotubes (Abstract). At least one substituent is selected from the group consisting of alkyl; acyl; aryl; aralkyl; halogen; substituted thiol; unsubstituted thiol; substituted amino; unsubstituted amino; hydroxyl (Column 3). The derivatized carbon nanotubes are inherently soluble in some medium.

Hiura does not expressly state that the carbon nanotubes are single-wall carbon nanotubes.

Iijima discloses a method of producing single-walled carbon nanotubes (Paragraph 2). Hiura and Iijima are analogous art because they are from the same field of endeavor, namely processes involving carbon nanotubes.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to form the process of Hiura to include the use of Single walled carbon nanotubes in view of the teaching of Iijima. The suggestion or motivation of doing so would have been to derivatize single-walled carbon nanotubes.

Response to Arguments

Applicant's arguments filed 6/29/06 have been fully considered but they are not persuasive.

The applicant argues that "not only would the teaching of Hiura when combined with the teachings of Iijima not have suggested a reasonable likelihood of success as applied to single-wall carbon nanotubes, such a chemical protocol would fail to achieve the desired results". To support this argument the applicant recites "Hiura primarily teaches the purification of multi-wall carbon nanotubes. Such purification is carried out by reacting such nanotubes with highly oxidative acids and/or oxidation agents under reflux and/or ultrasonic conditions. Such purification damages the multi-wall structures, as shown graphically in Hiura (Fig. 3). Application of the teachings of Hiura to multi-wall carbon nanotubes, typically riddled with defects, results in the breaking of carbon-carbon bonds generally at regions of defects on the walls as well as the ends. See Hiura at Figure 3. However, because of their multi-wall structure, the multi-wall nanotubes can withstand attack to their wall layers and still remain intact. As will be appreciated by one of skill in the art, such bond splitting with single-wall carbon nanotubes would be expected to result in destruction of the single-wall nanotubes". However this argument is not persuasive because the instant process is also carried out by reacting nanotubes with highly oxidative acids and/or oxidation agents under reflux conditions. Therefore, it appears that the process of Hiura in view of Iijima and the instantly claimed process would produce similar results.

The applicant argues that it would not have been obvious to a person of ordinary skill in the art to combine Hiura and Iijima to successfully obtain the claimed invention.

Art Unit: 1754

The applicant cites "gas-phase oxidation, which yields purified multishell nanotubes, destroys the single-shell nanotubes before anything else in the sample" found in "Purification of Single-Shell Nanotubes," Adv. Mater., 10 No. 8, 611-613 (1998) ("Dujardin") in support of this argument. However, gas-phase oxidation is not taught by the process of Hiura, therefore the teaching of Dujardin does not sufficiently render the combination of Hiura and Iijima nonobvious.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fiorito whose telephone number is (571)272-7426. The examiner can normally be reached on 9am - 6pm.

Art Unit: 1754

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Fiorito
Patent Examiner
AU 1754

JF

Steven Bos
Primary Patent Examiner
AU 1754

